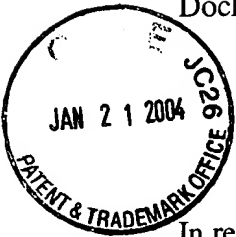


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2-2-04

Docket No.: 113708.122

PATENT/OFFICIAL



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Applicant: Eugene M. LEE

Serial No.: 09/409,524

Filed: September 30, 1999

For: SYSTEMS AND METHODS FOR PREPARATION
OF AN INTELLECTUAL PROPERTY FILING IN
ACCORDANCE WITH JURISDICTION AND/OR
AGENT-SPECIFIC REQUIREMENTS

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

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: Examiner: Jonathan P.
: Ouellette
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: Art Unit: 3629
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RECEIVED

JAN 29 2004

GROUP 3600

SUBMISSION OF APPELLANT'S BRIEF UNDER 37 C.F.R. § 1.192

Appellant submits herewith, in triplicate, Appellant's Brief under 37 C.F.R. § 1.192.

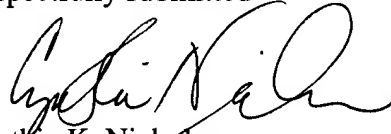
The Appellant's Brief is being submitted after the filing of the Notice of Appeal, i.e., July 22, 2003. Applicant petitions the Commissioner of Patents and Trademarks to extend the time for submitting the brief for four months (Notice of Appeal filed July 22, 2003, and the four month extended period from October 22, 2003 until January 22, 2004).

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[Handwritten signature]

Please charge the \$740.00 fee (small entity - 1/2 of \$1,480.00) to cover the cost of the extension to Deposit Account No. 08-0219. Any deficiency or overpayment should be charged or credited to Deposit Account No. 08-0219.

Respectfully submitted



Cynthia K. Nicholson

Registration No. 36,880

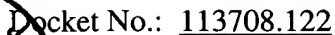
Date: January 21, 2004

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PATENT/OFFICIAL

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GROUP 3600

APPEAL BRIEF UNDER 37 C.F.R. § 1.192

This is an Appeal Brief from the final rejection of the Final Office Action mailed January 23, 2003, having a three-month shortened statutory period of response set to expire April 23, 2003, extended to July 22, 2003, and Notice of Appeal filed on July 22, 2003. This Brief is being filed in triplicate.

REAL PARTY IN INTEREST

This application is assigned to Knowledge Management Objects, L.L.C.

RELATED APPEALS AND INTERFERENCES

A Notice of Appeal was filed in co-pending related application Ser. No. 09/460,806 on July 25, 2003. There are no other Appeals or Interferences that may directly affect or be directly affected by or have a bearing on the Board's decision in the instant Appeal.

STATUS OF THE CLAIMS

This patent application was initially filed on September 30, 1999, with the U.S. Patent and Trademark Office. As filed, the application included 56 claims.

In a first Office Action dated June 12, 2002, claims 1-56 were rejected for indefiniteness, double patenting, anticipation or obviousness. Prior art rejections were based on Hunter et al., U.S. Patent 6,298,327 ("*Hunter*") alone or in combination with Bezos et al., U.S. Patent 6,029,141 ("*Bezos*") and Ferguson et al., U.S. Patent 5,819,092 ("*Ferguson*").

Appellant responded to the first Office Action with an Amendment filed on December 12, 2002, addressing the rejection, amending the claims, adding new claim 57 and attempting to place the application in a condition of allowance.

A final Office Action was issued rejecting claims 1-57 for obviousness on January 23, 2003. The prior art rejections were based on new references www.inventnet.com ("*InventNet*") in view of The World Intellectual Property Organization PCT-Easy User Reference Manual, January 1999 ("*WIPO*"). InventNet and WIPO are cited and described in detail in the Background Art section of the present application under appeal.

A reply was filed on July 22, 2003, addressing the rejections in the final Office Action.

This Appeal follows.

The status of the pending claims is as follows:

Allowed claims: none; and

Claims rejected and on appeal: 1-57.

STATUS OF AMENDMENTS

No amendment of the claims was filed subsequent to the Final rejection. A copy of the claims, as they now stand, is provided in the attached Appendix.

SUMMARY OF THE INVENTION

Appellant's invention is directed to solving the problem of "preparing intellectual property filings in accordance with jurisdiction- and/or agent-specific requirements." In general, embodiments of the invention relate to a facility whereby an applicant (or his representative) may file corresponding applications in multiple jurisdictions using multiple associates while automating the preparation of filings in accordance with both jurisdiction-specific and associate-specific requirements and/or procedures. Referring for example to Figure 2, an intellectual property filing portal or hub (210) communicates with both applicants (e.g., 221) and associates (e.g., 231, 234). Target jurisdictions include, e.g., EPO, JPO and RO/US (241, 242, 253). A foreign filing session is initiated (201) by requesting target jurisdiction and associate information from the portal (210), which are sent to the user (221). Responsive to a selection of particular associates and target jurisdictions by the user (221), the portal (210) supplies the user (221) with target-and associate-specific requirements, e.g., form documents, formal requirements, and fee schedules for the associate-and target-jurisdiction combination. The user (221) computer may populate the formal documents. The user authorizes (206) the filings for the combination, transmits the filing documents (207) to the portal (210), which are, in turn, forwarded (208A, B) to the respective associates for filing. (Specification page 14, line 4 to page 16, line 30).

Reference is now made to Figure 3. According to one or more embodiments of the present invention, operating the intellectual property filing portal includes servicing intellectual property filing transactions, supplying the user with a computer-readable encoding of form documents, receiving from the user, via the network, at least a portion of a set of filing documents, and forwarding the same to the selected associate for filing in the selected jurisdiction. Form documents are specific to target jurisdiction and associate, and are supplied

responsive to a selection of target jurisdiction and associate. (Specification page 5, line 23 – page 6, line 3).

ISSUES

Issue 1: Are claims 1 – 57 unpatentable under 35 U.S.C. § 103 as being obvious over www.inventnet.com (“*InventNET*”) in view of The World Intellectual Property Organization PCT-Easy User Reference Manual, January 1999 (“*WIPO*”)?

GROUPING OF CLAIMS

For the purpose of this appeal, claim 4 is grouped with claim 1; claim 13 is grouped with claim 5; claims 45, 46 and 50 are grouped with claim 44; and claim 55 is grouped with claim 54.

The remaining claims do not stand or fall together. Instead, each of the remaining claims are believed to each have separate basis of patentability and are separately argued below.

ARGUMENT

Claims 1-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over www.inventnet.com screenprint 11/7/1996 (“*InventNet*”) in view of The World Intellectual Property Organization PCT-Easy User Reference Manual January 1999, <http://pcteasy.wipo.int/en/index.html> (“*WIPO*”). For the reasons including, *inter alia*, those discussed below, each of independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56 is patentable over the applied references. Claims dependent therefrom are similarly patentable. The rejection cannot withstand scrutiny and should be reversed for the reasons given below.

BACKGROUND

Background: Inventnet.com and PCT-Easy User Reference Manual (“*WIPO*”)

Inventnet states that it is an Internet based inventor's network. InventNet is a web site with sections titled, e.g., "Patenting Help", "Inventions for Sale," "Patent Attorneys," "About InventNET," "Patent Forms," "Patent Search," "News," "Hot Links," "Prototype Work," "Product Services," and "InventNET Inventors." The Patenting Forms Section has links to USPTO forms on the USPTO web site. Inventnet includes a Patent Attorney Directory, listing certain at least one patent attorney by zip code.

WIPO, published by the World Intellectual Property Organization, is a User Reference Manual for the PCT-EASY Electronic Application System. WIPO claims to be "software designed to facilitate the preparation of PCT international patent applications." WIPO's documents conform solely to WIPO format. WIPO discloses, for example:

"PCT-EASY (Electronic Application SYstem) is software designed to facilitate the preparation of PCT international patent applications in electronic form and, ultimately, the transfer of such applications by electronic means.

This version of the PCT-EASY software, however, will be limited to ...

- printout of a PCT computer generated Request form...;
- possibility of copying the PCT-EASY Request form data file and attached abstract to diskette for submission with the complete paper filing."

(WIPO p. 1-3).

In connection with "Creating a PCT International Patent Application," WIPO states:

"The completed form generated using PCT-EASY replaces the standard Request form (PCT/RO/101) normally used. ... This printout must accompany the rest of the international application in paper form." (WIPO p. 1-7).

ISSUE 1:

Are claims 1-57 are unpatentable under 35 U.S.C. § 103 as being obvious over InventNet in view of WIPO?

A. No Prima Facie case of obviousness can exist under 35 USC § 103 because at least one of the references relied upon has an effective date after the filing date of the present application.

The claims stand rejected under 35 U.S.C. § 103(a). Section 103(a) requires that the subject matter “would have been obvious at the time the invention was made.” A reference with an effective date subsequent to the filing date of the application cannot be used in a rejection under 35 U.S.C. § 103(a).

Claims 1-57 stand rejected over InventNet in view of WIPO. InventNet has an effective filing date after the application’s filing date of September 30, 1999 for the reasons detailed below. Consequently, the rejection must be reversed.

Inventnet is listed in the Notice of References Cited (Paper 13) as “www.inventnet.com, 11/7/1996, Screen Print”. InventNet, however, is a collection of pages, including several subsequent to the screenprint date of 11/7/1996 asserted in the Form 892.¹ Further, some of these pages are dated after the filing date of the present application:

- (a) page 1, listing “waybackmachine” and “Search Results for Jan 01, 1996 – Jan 27, 2003” and a print date (lower right hand corner) of “1/27/03”;
- (b) page 8 has a url of “http://web.archive/prg/web/19990209084002/www.inventnet.com/forms.html”, the string “1999” indicating the year the document was archived;
- (c) page 11 has a print date of “1/27/03”; and

¹ WIPO is the other of the applied references; the designation in the citation “http://pcteasy.wipo.int/en/index.html” suggests that this is an index to various parts of a web site although no copy of a web page was provided. A letter correcting the apparent errors concerning WIPO and InventNet together with a correct copy of the references and a corrected form 892 was requested under MPEP § 707.05(g), with Appellant’s Reply filed July 22, 2003. Appellant is still awaiting a response to the request for letter of correction.

(d) pages 12-16 have a print date of “1/22/03”, and elements titled “New Patent Fees starting October 2001”, “Images from Yankee Invention Exhibition 2000”, and “Copyright © 1995-2002”.

InventNet includes material dated after the filing date of the present application, September 30, 1999. The reference is relied on in its entirety without specifying particular pages. Because the rejection under 35 USC § 103(a) relies on the entire reference, and the reference as a whole includes portions dated after the filing date of the present application, the rejection under 35 U.S.C. § 103(a) cannot withstand scrutiny and must be reversed.

B. There is no Prima Facie case of obviousness because the references fail to teach or suggest all claim limitations.

To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Where, as here, the Examiner fails to establish a *prima facie* case of obviousness, Appellant has no burden to rebut the rejection of obviousness with evidence. In re Rijckaert, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more Appellant is entitled to grant of patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

Appellant provides herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Inventnet and/or WIPO, alone or in combination. The final Office Action contends that Inventnet suggests or teaches registering for each of the plural associates (e.g., a patent attorney directory listing contact information for attorneys by area code), not only at least one target jurisdiction but also “a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications” (independent claim 1).² (No specific page of Inventnet is cited in the Office Action with respect to any claim.)

Concerning claim 1, assuming *arguendo* that Inventnet discloses a Patent Attorney Directory, it does not teach or suggest, for example “registering for each of plural associates ... form documents,” or that the documents so registered are “corresponding to target jurisdiction and associate specifications,” or “distributing at least a portion of the form documents to an originating filer,” or “distributing at least a portion of the form documents ... for use in preparation of intellectual property documents suitable for filing” (independent claim 1).

The final Office Action admits that Inventnet “fails to distinctly disclose distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates.” (Final

² Appellant does not admit that InventNet is a proper reference under 35 USC §103(a), for the reasons provided above.

Office Action, ¶ 6). Recognizing that Inventnet fails to teach and/or suggest the invention as claimed, WIPO, in its entirety, is cited to remedy the deficiencies.

Nevertheless, WIPO fails to remedy such deficiencies. For example, the creation of a PCT Request Form in accordance with WIPO does not teach or suggest “a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications.” WIPO also fails to teach or suggest “distributing” such registered documents “to an originating filer” to prepare documents for “filing by respective ones of the associates” that are registered. WIPO further does not teach or suggest registering, for associates, a target jurisdiction and such form documents.

Hence, Inventnet and WIPO, alone or in combination, fail to teach or suggest the combination of features recited in the claim 1, when considered as a whole.

Furthermore, Inventnet and/or WIPO operate in a fundamentally different way than the claimed invention. Specifically, neither Inventnet nor WIPO teach or even suggest, let alone disclose, anything concerning intellectual property documents suitable for filing by particular associates. Moreover, neither Inventnet nor WIPO teach or suggest a relation between a registered associate, and form documents corresponding to the associate specifications as well as the target jurisdiction. Inventnet and WIPO fail to teach or suggest registering a plurality of form documents corresponding to target jurisdiction and associate specifications. The Office Action cites the Patent Attorney Directory in Inventnet as disclosing this limitation, however, Inventnet is clearly deficient considering the invention as claimed as a whole. Consequently, the proposed combination fails to teach or suggest the claimed invention.

Claims 2-4 depend from claim 1, and are non-obvious for the reasons given above. With regard to dependent claim 2, InventNet and WIPO further fail to teach or suggest, e.g., that

documents are distributed “responsive to selection by the originating filer of one or more of the target jurisdictions and ... a respective one of the associates” (dependent claim 2). The Examiner admits, in connection with claim 1, that Inventnet fails to disclose distributing the form documents. Inventnet therefore fails to disclose any details of such distribution. Neither Inventnet nor WIPO teach or suggest a distribution in response to selection of jurisdiction and associate.

With respect to dependent claim 3, Inventnet and WIPO further fail to teach or suggest, for example, “periodic supply to the originating filer ... of at least a portion of the form documents for each of plural associates,” (dependent claim 3). The Examiner admits, in connection with claim 1, that Inventnet fails to disclose distributing the form documents. Inventnet therefore fails to disclose any details of such distribution. Neither Inventnet nor WIPO teach or suggest periodic supply of the form documents for each associate. Further, neither Inventnet nor WIPO teach or suggest “form documents for each of plural associates.”

With regard to independent claim 5, InventNet neither teaches nor suggests, for example, “an intellectual property filing portal coupled by the network to the originating node and at least a portion of the target nodes”, where the portal is “responsive to a selection at the originating node of at least one target jurisdiction and at least one associate corresponding thereto,” and “supplying the originating node with the particularized requirements of the selected at least one target jurisdiction and at least one associate;” where the portal, further responsive to “receipt ... of one or more intellectual property filings prepared in accordance with the particularized requirements ..., supplying ones of the target nodes” with intellectual property filings “for filing by respective ones of the selected at least one associate in respective ones of the selected at least one target jurisdiction” (independent claim 5).

Furthermore, the Office Action fails to consider the specific limitations of independent claim 5 (or the other remaining independent claims). Paragraphs 5-8 of the final Office Action mention only the limitations of claim 1. Nevertheless, the final rejection of claim 5 (and all other independent claims 15, 22, 25, 33, 41, 44, 52 and 56) is made in common with the rejection of claim 1, despite these claims reciting different limitations. Consequently, the final Office Action fails to consider whether InventNet or WIPO teach or suggest the specific limitations of claim 5 and fails to specify any particular portion of a reference to support the rejection. For this additional reason, the final Office Action fails to present a prima facie case of obviousness with respect to the limitations of claim 5 (and all other independent claims 15, 22, 25, 33, 41, 44, 52 and 56).

Claims 6-14 are dependent from claim 5, and are allowable for the reasons given above.

With regard to claim 6 (dependent from claim 5), InventNet and/or WIPO further fail to teach or suggest the “selection of two or more target jurisdictions” (dependent claim 6), where the filing portal is responsive to selection of the target jurisdictions and supplies the originating node with the particularized requirements therefor (claim 5). Neither reference teaches or suggests, e.g., particularized requirements of two or more target jurisdictions.

In connection with dependent claim 7, Inventnet and/or WIPO fail to teach or suggest that the particularized requirements for the selected target jurisdiction and at least one associate include “formatting requirements for filing of the intellectual property filing in the target jurisdiction” (dependent claim 7). Neither reference teaches or suggests, for example, formatting requirements particularized to target jurisdiction and associate.

Moreover, in connection with dependent claim 8, Inventnet and/or WIPO fail to teach or suggest, e.g., that the particularized requirements for the selected target jurisdictions and at least

one associate include “data fields for which values specific to the intellectual property filing are to be supplied from the originating node to allow preparation of documents for filing ... by the selected at least one associate” (dependent claim 8). Neither reference teaches or suggests, for example, supplying values from the originating node, and supplying the target node with intellectual property filings for filing (claim 8 in combination with claim 5).

Referring to dependent claim 9, Inventnet and/or WIPO fail to teach or suggest that, for “each selected at least one target jurisdiction and corresponding at least one associate,” the particularized requirements include an “encoding of at least one paper requested by the selected at least one associate” (dependent claim 9).

With regard to dependent claim 10, Inventnet and/or WIPO fail to teach or suggest, for example, “wherein at least a portion of the target nodes include a computer of a respective associate” (dependent claim 10).

In connection with dependent claim 11, Inventnet and/or WIPO fail to teach or suggest, for example, that the originating node includes a “web browser,” and the filing portal includes a “web server,” where the requirements are supplied and the prepared filings are received using the internet between the web browser and the web server (claim 11). Neither reference teaches or suggest a web browser or server, or the supply of requirements and prepared filings therebetween as claimed.

With regard to dependent claim 12, Inventnet and/or WIPO fail to teach or suggest, for example, that the portal is responsive to “registration by one or more of the associates of particularized requirements for the corresponding at least one target jurisdiction”, and wherein the requirements supplied to the originating node “include those registered by the selected at least one associate” (dependent claim 12).

In connection with dependent claim 14, Inventnet and/or WIPO fail to teach or suggest, e.g., a “computer readable encoding of a technical document including specification and claims” (dependent claim 14).

The rejection of independent claim 15 was made in common with claim 1 without regard to the limitations recited in claim 15. For the reasons given in connection with claim 5, the final Office Action therefore fails to present a prima facie case of obviousness with respect to claim 15.

Further with regard to independent claim 15, InventNet and/or WIPO, alone or in combination, neither teach nor suggest, for example, “responsive to a selection by a user of at least one target jurisdiction and at least one associate corresponding thereto, supplying the user ... with a computer readable encoding of one or more form documents, wherein the form documents are specific to the at least one target jurisdiction and at least one associate” or “receiving from the user ... one or more documents suitable for filing ... and forwarding same to the selected at least one associate” (independent claim 15).

Claims 16-21 depend from claim 15, and are allowable for reasons given above.

With regard to claim 16 (dependent from claim 15), InventNet and/or WIPO further fail to teach or suggest, for example, registering associates in one or more target jurisdictions, “the registering including updating a data store with computer readable encodings of one or more form documents” where the form documents are “specific to at least one associate and the at least one target jurisdiction” (dependent claim 16);

In connection with dependent claim 17, Inventnet and/or WIPO fail to teach or suggest, for example, “providing one or more quoted fees associated with both the at least one target

jurisdiction and the at least one associate” or where the form documents are supplied “contingent upon authorization by the user of the quoted fees” (dependent claim 17).

With respect to dependent claim 18, Inventnet and/or WIPO fail to teach or suggest “providing one or more quoted fees associated with both the at least one target jurisdiction and the at least one associate,” where the providing is “substantially coincident with the selection” by a user of the target jurisdiction(s) and corresponding associate(s); and “transacting the quoted fees substantially coincident with the one or more of the selection, the receiving ... and the filing” (dependent claim 18).

Now considering claim 19 (dependent from claim 18), Inventnet and/or WIPO fail to teach or suggest, e.g., “transacting” the quoted fees associated with the target jurisdiction and the associate as claimed (dependent claim 19).

With regard to dependent claim 20, Inventnet and/or WIPO fail to teach or suggest “responsive to a selection by the user of the at least one target jurisdiction and the at least one associate corresponding thereto” retrieving the filing requirements “for technical documents”, and preparing the “technical documents” (dependent claim 20).

In connection with dependent claim 21, Inventnet and/or WIPO fail to teach or suggest, for example, “supplying the user ... with the computer readable encoding of target jurisdiction filing requirements for technical documents” and “performing the preparing at the user’s site using the computer readable encoding” and “receiving from the user, via the network, the prepared one or more technical documents” (dependent claim 21).

The rejection of independent claim 22 was made in common with claim 1, without consideration of the limitations in claim 22. For the reason provided in connection with claim 5, the final Office Action fails to present a prima facie case of obviousness with respect to claim 22.

Moreover, further in connection with independent claim 22, InventNet and WIPO, alone and/or in combination, fail to teach or suggest, for example, “receiving ... a transmission from a user, having at least one selection of two or more target jurisdictions and corresponding one or more associates for an intellectual property filing,” “supplying a transmission ... of one or more target jurisdiction and associate specific documents for completion,” “receiving ... completed one or more target jurisdiction and associate-specific documents,” and “forwarding ... respective ones of the target jurisdiction and associate-specific documents, to each of the selected one or more associates” (independent claim 22).

Claims 23-24, which depend from claim 22 are allowable for the reasons given above. Moreover, InventNet and/or WIPO fail to teach or suggest, for example, “providing one or more quoted fees associated with the selected two or more target jurisdictions and corresponding one or more associates” or where the target jurisdiction and associate-specific documents are supplied “contingent upon authorization by the user of the one or more quoted fees” (dependent claim 23); and “populating” the jurisdiction and associate-specific documents with information, or that documents are populated with “matter specific information” (dependent claim 24).

Independent claim 25 was rejected in common with claim 1, disregarding the limitations of claim 25. The final Office Action therefore fails to present a prima facie case of obviousness with respect to independent claim 25, as further discussed in connection with claim 5.

Moreover, InventNet and WIPO, alone or in combination, fail to teach or suggest, for example, responsive to a selected “target jurisdiction”, “obtaining a computer readable encoding of one or more form documents” wherein the documents are “specific to the target jurisdiction and to a respective associate therefore,” and “supplying at least a portion of a set of filing documents” in accordance with such form documents (independent claim 25).

Claims 26-32 depend from claim 25 and are allowable for the reasons given above. In addition, InventNet and/or WIPO, alone or in combination, fail to teach or suggest, for example, “completing” the jurisdiction and associate-specific form documents in accordance with “matter specific information retrieved from a data store” (dependent claim 26).

With regard to dependent claim 27, Inventnet and/or WIPO fail to teach or suggest, for example, selecting not only a target jurisdiction but also “selecting the respective associate from amongst a set of supported associates” (dependent claim 27).

In connection with both dependent claims 28 and 29, Inventnet and/or WIPO fail to teach or suggest, e.g., that the documents are obtained “from an intellectual property filing portal” (dependent claims 28 and 29).

Considering both dependent claims 28 and 30, Inventnet and/or WIPO fail to teach or suggest, for example, that “supplying” the documents for transfer to the respective associate includes supplying “to the intellectual property filing portal for forwarding to the respective associate” (dependent claims 28 and 30).

With regard to dependent claim 31, Inventnet and/or WIPO fail to teach or suggest, for example, that the documents are obtained and supplied “via a network” and the supplied portion of the documents “includes at least a computer readable encoding of one or more technical documents” (dependent claim 31)

Considering dependent claim 32, Inventnet and/or WIPO fail to teach or suggest, for example, that the supplied portion of the filing documents “include one or more technical documents and completed ones of the one or more form documents” (dependent claim 32).

With regard to independent claim 33, the final Office Action fails to make a prima facie case of obviousness because the specific limitations of claim 33 are not considered. Arguments made with respect to claim 5 are incorporated herein.

Moreover, InventNet and/or WIPO, alone or in combination, nevertheless fail to teach or suggest various elements recited in independent claim 33, for example, selecting one or more target jurisdiction, and for each selected target jurisdiction, selecting attorneys; and “for each selected target jurisdiction, transforming a computer readable encoding of intellectual property application data to a format appropriate for filing ... and electronically transmitting the transformed computer readable encoding to an attorney or agent for filing in the selected target jurisdiction” (independent claim 33).

Furthermore, claims 34-40, dependent from claim 33, are neither taught nor suggested by InventNet and/or WIPO, alone or in combination. WIPO and/or InventNet fail to teach or suggest, for example, that the transforming (of the computer readable encoding of intellectual property application data) is in accordance with requirements for the selected target jurisdiction (independent claim 33). With regard to dependent claim 34, Inventnet and/or WIPO fail to teach or suggest that the transforming is further in accordance with “the selected attorney or agent’s requirements” (dependent claim 34).

With regard to each of dependent claims 35 and 36, Inventnet and/or WIPO fail to teach or suggest that the intellectual property application data which is transformed “includes contents of a priority application” (dependent claim 35), or “data retrieved from a docket system” (dependent claim 36).

In addition to the foregoing, with regard to claims 35-36 and 49, the first Office Action argued that it would have been obvious to include, as data that is transformed to a format

appropriate for filing (per claim 33), contents of a priority application (claim 35), data retrieved from a docket system (claim 36) or a priority application corresponding to a previously filed intellectual property application (claim 49).³ Such specifics are neither taught nor suggested by WIPO and/or Inventnet, alone and/or in combination. Accordingly, considering each of claims 35, 36 and 49 as a whole, there is no prima facie case of obviousness.

Considering now both dependent claims 37 and 38, Inventnet and/or WIPO fail to teach or suggest where the transformed computer readable encoding of the format appropriate for filing is “via an information service intermediary” (dependent claim 37, 38). Considering now dependent claim 38, Inventnet and WIPO fail to teach or suggest, e.g., that the “transforming” is performed by the information service intermediary” (dependent claim 38).

In connection with dependent claim 40, Inventnet and/or WIPO fail to teach or suggest that the intellectual property application data is represented “in a target-neutral format prior to the transforming thereof” (dependent claim 40).

With reference to independent claim 41, the final Office Action failed to consider the limitations therein separate from claim 1. For the reasons given in connection with claim 5, the Office Action fails to state a prima facie case of obviousness.

Further with regard to independent claim 41, InventNet and/or WIPO fail to teach or suggest, for example, receiving “at a target computer” “a selection of one or more target jurisdictions,” and responsive to the receipt of the selection, “supplying, from the target

³ The Examiner previously took notice that allegedly these are well known information fields that are part of the application process at the United States Patent and Trademark Office. In response to the Examiner’s notice, Appellant initially requested that if the Examiner maintains his position that a “computer readable encoding of intellectual property application data” includes the “contents of a priority application,” includes “data retrieved from a docket system,” or includes “priority application data content corresponding to a previously filed intellectual property application,” respectively, that he should provide the required evidence thereof. MPEP § 2144.03. It appears that, in response to Appellant’s request, the Examiner generally cited the entire contents of WIPO and Inventnet. (Final Office Action ¶ 5.)

computer ... a computer readable encoding of filing requirements for the selected one or more target jurisdictions” (independent claim 41).

Furthermore, dependent claims 42 and 43 are allowable because, additionally InventNet and/or WIPO fail to teach or suggest, e.g., “for each target jurisdiction selection, receiving a selection of at least one attorney and/or agent corresponding thereto”, and where the “computer readable encoding of filing requirements includes attorney and/or agent-specific requirements” (dependent claim 42); or transmitting a “computer readable encoding of a technical document for filing ...” (dependent claim 43).

The final Office Action failed to consider the limitations of independent claim 44 separate from claim 1. Consequently, and for the reasons given above in connection with claim 5, the final Office Action fails to state a prima facie case of obviousness.

Moreover, in connection with claim 44 concerning “an information system for preparing intellectual property filings for at least one target in accordance with requirements thereof” and claims dependent therefrom, InventNet and/or WIPO, alone or in combination, fails to teach or suggest, for example, “a selection facility by which a user thereof selects the at least one target”, an interface to application data, an interface to target requirement data, and a filing preparation facility to “transform the intellectual property application data “into a target specific intellectual property application filing format ... in accordance with the target requirement data,” and “preparing at least one additional document in accordance with the intellectual property application and suitable for filing in accordance with target requirement data” (independent claim 44).

Claims 45-51 are dependent from claim 44 and are allowable for the reasons given above, and for the additional example reasons provided below.

In connection with dependent claim 47, InventNet and/or WIPO fail to teach or suggest, for example, that the “target includes a target jurisdiction and/or convention,” (claim 47).

Moreover, with regard to dependent claim 48, Inventnet and/or WIPO fail to teach or suggest, e.g., that “the target further includes an attorney and/or agent,” (dependent claim 48); or that the target includes an attorney and/or agent, and the “target requirement data further includes attorney- and/or agent-specific requirements” (dependent claim 48).

In connection with dependent claim 49, neither Inventnet nor WIPO teach or suggest that the intellectual property application data “includes a priority application data content corresponding to a previously filed intellectual property application” (dependent claim 49).

With regard to dependent claim 51, Inventnet and/or WIPO fail to teach or suggest where the information system is “embodied as a client application executable on an originating computer” and where “at least the requirement data is hosted by the server application” (dependent claim 51).

In connection with independent claim 52, the final Office Action fails to consider the limitations in this claim and hence fails to state a case of prima facie obviousness. Nevertheless, InventNet and/or WIPO fail to teach or suggest, for example, selection code to “select one or more target jurisdictions and respective associates”, retrieval code to retrieve “target jurisdiction- and associate- specific filing requirements,” document preparation code to prepare “target jurisdiction- and associate-specific documents”, and filing initiate code to transmit “the prepared documents” (independent claim 52).

With regard to dependent claim 53, InventNet and/or WIPO fail to teach and/or suggest, for example, where the “selection code, the retrieval code, the document preparation code and the filing initiation code are all executable on a same processor” (dependent claim 53).

Concerning independent claim 54, the final Office Action fails to state a case of prima facie obviousness in connection with the elements of this claim. The Office Action recited the elements of claim 1 instead. Nevertheless, InventNet and/or WIPO, alone or in combination, fail to teach or suggest, for example, a method of making a computer readable encoding of “target jurisdiction- and associate-specific form documents”, including “maintaining a data store of target jurisdiction- and associate-specific form documents” for transacting an intellectual property filing in the target jurisdiction(s), encoding “an enumeration, for transmission to a computer, of at least a subset of the target jurisdictions and respective of the associates therefore”, and receiving a selection of target jurisdiction(s) and respective associates, retrieving form documents based on the selection, and encoding the retrieved “target jurisdiction- and associate-specific form documents” (independent claim 54).

Similarly, the Office Action fails to state a prima facie case of obviousness with respect to claim 56, by ignoring its limitations. However, InventNet and/or WIPO, alone or in combination, fails to teach or suggest, for example, “means for selecting one or more target jurisdictions and respective associates,” and “means for transmitting a technical document and respective of the completed form documents, for filing by the elected associates (independent claim 56).

Dependent claim 57 is allowable, for the above reasons and moreover because InventNet and WIPO, alone or in combination fail to teach or suggest, for example, that “one or more target jurisdiction and associate-specific documents include one or more technical documents” (dependent claim 57).

C. No motivation to combine the references has been provided

In addition, there is no suggestion or motivation to combine the references. “There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” In re Oetiker, 977 F.2d 1443, 24 USPQ.2d 1443 (Fed. Cir. 1992). Moreover, to establish a prima facie case of obviousness, “it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention.” In re Levengood, 28 USPQ.2d 1300, 1301 (Bd. Pat. App. 1993).

Failure to point to specific information that teaches or suggests the combination claimed cannot support a conclusion of obviousness. In re Dembiczak, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). “Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ.2d 1313, 1317 (Fed. Cir. 2000). See also Crown Operations Int’l Ltd. V. Solutia Ina., 289 F.3d 1367, 1376, 62 USPQ.2d 1917 (Fed Cir. 2002) (“there must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, ... to look to particular elements, and to combine them as combined by the inventor”).

The Office Action provides no motivation to combine an Attorney directory with a manual on preparing PCT request forms, other than the conclusory statement in paragraph 8 of the Final Office Action that the combination would be made “for the advantage of operating an information service to facilitate preparation of intellectual property documents with the ability of

users to select from a list of registered associates, be supplied the necessary form documents, and have the associate file for the intellectual property rights.” One cannot glean from Inventnet a motivation to combine its patent attorney directory or other materials with, e.g., WIPO’s reference manual. Nor can one glean from WIPO a motivation to offer inventor group materials of any type.

In determining whether a suggestion can be fairly gleaned from the prior art, one must consider the full field of the invention, “including that which might lead away from the claimed invention.” In re Dow Chemical, 837 F.2d 469, 473, 5 USPQ.2d 1529, 1531 (Fed. Cir. 1988). Here, Inventnet instructs its users themselves to use a patent attorney to prepare the necessary documents (“Patenting Help” page screen).

Moreover, assuming *arguendo* that it may have been possible to access both WIPO and Inventnet over the Internet, that in itself provides no motivation to combine the references as proposed by the Examiner. To the contrary, where the prior art does not suggest the combination or convey a reasonable expectation of success of making it, there is no *prima facie* case of obviousness. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991).

The claimed subject matter “as a whole” must be considered in determining obviousness. E.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 449 230 USPQ 416, 420 (Fed. Cir. 1986). Here, because there is no motivation for the combination of Inventnet and WIPO, and even the proposed combination fails to teach at least one feature taken in combination with the remainder of features of the claimed invention, the Examiner has failed to establish obviousness generally, as well as the requisite *prima facie* case. Accordingly, Appellant is not presenting, at this time, objective evidence tending to support a conclusion of non-obvious, since no such evidence is necessary at this time.

D. The Proposed Combination fails to teach or suggest the invention as a whole.

Assuming *arguendo* the suggested motivation, the proposed combination of references still fails to teach or suggest the invention as claimed. For example, the combination of WIPO and Inventnet still fail to provide an ability for users to select from a list of registered associates the target jurisdiction and associate-specific form documents, and have the associate file for the intellectual property rights.

The claimed subject matter “as a whole” must be considered in determining obviousness. E.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., *supra*. Here, the proposed combination fails to teach at least one feature taken in combination with the remainder of features of the claimed invention.

Assuming *arguendo* a motivation to combine the two references, the proposed modification would appear to change the principle of operation of either Inventnet or WIPO, or both. Inventnet, an inventor’s network, does not appear to be appropriate for offering its users a how-to manual on preparing and filing a PCT request. Indeed, InventNet recommends using an attorney for filing. On the other hand, the WIPO reference manual is not a “plurality of form documents corresponding to target jurisdiction and associate specifications”, registered for each of plural associates. The proposed combination would modify the WIPO PCT request form further to accommodate different associate specifications, for example. Hence, the proposed combination would appear to require some basic changes to the fundamental principles upon which Inventnet and WIPO operate in order for each to accommodate the other in the manner proposed by the Examiner.

Moreover, it appears that the Examiner is impermissibly relying on hindsight, including Applicant’s own disclosure and references such as portions of InventNet and the page

<http://pcteasy.wipo.int/en/index.html>, available only after the filing data of the present application. “[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teaching of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992).

The fact that an invention in hindsight may appear to be simple, does not mean the invention is not patentable. As stated by the Federal Circuit:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting claims 1, 2, and 4-9 under 35 U.S.C. § 103(a) over Evans. Moreover, because the rejections of claims 3 and 10 rely upon the foregoing, we also conclude that the Board did not make out a proper prima facie case of obviousness in rejecting those claims under 35 U.S.C. § 103(a).

In re Kotzab, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000).

For at least these reasons, the combination of features recited in independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56 when interpreted as a whole, is submitted to patentably distinguish over the prior art.

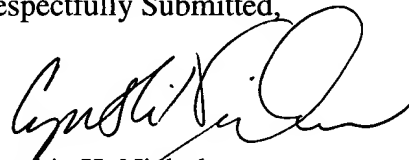
With respect to the rejected dependent claims, Applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 or 56, but also because of additional features they recite. Examples of some of these features were discussed previously.

For all the reasons advanced above, Applicant respectfully submits that the rejection of claims 1-57 must be reversed.

CONCLUSION

For the reasons advanced above, Appellant respectfully contends that each claim is patentable. Therefore reversal of all rejections is courteously solicited.

Respectfully Submitted,



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APPENDIX

1. (Previously Presented) A method of operating an information service to facilitate preparation of intellectual property documents suitable for filing in one or more of plural target jurisdictions, the method comprising:

registering for each of plural associates, at least one target jurisdiction and a computer

readable encoding of a plurality of form documents corresponding to target

jurisdiction and associate specifications; and

distributing at least a portion of the form documents to an originating filer for use in

preparation of the intellectual property documents suitable for filing by respective

ones of the associates.

2. (Original) The method of claim 1,

wherein the distribution is responsive to selection by the originating filer of one or

more of the target jurisdictions and, for each selected target jurisdictions, a

respective one of the associates.

3. (Previously Presented) The method of claim 1,

wherein the distribution includes periodic supply to the originating filer of the

computer readable encoding of at least a portion of the form documents

for each of plural associates.

4. (Previously Presented) The method of claim 1,

wherein the distribution is encoded by and/or transmitted in at least one computer

readable medium selected from the set of a disk, CD-ROM, tape or other

magnetic, optical, or electronic storage medium and a network, wireline,

wireless or other communications medium.

5. (Previously Presented) An information system for transacting an intellectual property filing with plural targets therefor, the information system comprising:

a network including an originating node and plural target nodes, the target nodes corresponding to associates licensed or otherwise authorized to make intellectual property filings in one or more target jurisdictions; and an intellectual property filing portal coupled by the network to the originating node and at least a portion of the target nodes, the intellectual property filing portal responsive to a selection at the originating node of at least one target jurisdiction and at least one associate corresponding thereto for the intellectual property filing, supplying the originating node with particularized requirements of the selected at least one target jurisdiction and at least one associate,

the intellectual property filing portal further responsive to receipt via the network of one or more intellectual property filings prepared in accordance with the particularized requirements of the selected at least one target jurisdiction and at least one associate, supplying corresponding ones of the target nodes with respective portions of the received one or more intellectual property filings for filing by respective ones of the selected at least one associate in respective ones of the selected at least one target jurisdiction.

6. (Original) The information system of claim 5,

wherein the selection at the originating node includes selection of two or more target jurisdictions.

7. (Previously Presented) The information system of claim 5, wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include:

formatting requirements for filing of the intellectual property filing in the target jurisdiction; and

an encoding of at least one filing suitable for filing at the target jurisdiction.

8. (Previously Presented) The information system of claim 5, wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include:

information characterizing one or more data fields for which values specific to the intellectual property filing are to be supplied from the originating node to allow preparation of documents for filing in the selected at least one target jurisdiction by the selected at least one associate.

9. (Previously Presented) The information system of claim 5, wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include:

an encoding of at least one paper required by the selected at least one associate.

10. (Previously Presented) The information system of claim 5, wherein the originating node includes a computer of a managing attorney or intellectual property owner; and

wherein at least a portion of the target nodes include a computer of a respective associate configured to electronically receive at least a portion of the intellectual property filing from the originating node via the intellectual property filing portal.

11. (Previously Presented) The information system of claim 5, wherein the originating node includes a web browser; wherein in the intellectual property filing portal includes a web server; and wherein the selection of at least one target jurisdiction and at least one associate, the supplying of the particularized requirements, and the receipt of the one or more intellectual property filings prepared in accordance with the particularized requirements are achieved, at least in part, using internet protocol traffic between the web browser and the web server.

12. (Previously Presented) The information system of claim 5, wherein the intellectual property filing portal is further responsive to registration by one or more of the associates of particularized requirements for the corresponding at least one target jurisdiction; wherein the supplied particularized requirements include those registered by the selected at least one associate.

13. (Original) The information system of claim 5, wherein the network includes one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications network segment, and a virtual private network.

14. (Original) The information system of claim 5, wherein the received intellectual property filings include one or more of:
- a computer readable encoding of a technical document including specification and claims formatted in accordance with the supplied particularized requirements of at least a first of the selected target jurisdictions; and
 - a computer readable encoding of information for completion of a filing paper, request for examination or transmittal in accordance with the supplied particularized requirements of the first selected target jurisdiction and the selected associate therefor.
15. (Previously Presented) A method of operating an intellectual property filing portal for servicing intellectual property filing transactions using a network accessible information service, the method comprising:
- responsive to a selection by a user of at least one target jurisdiction and at least one associate corresponding thereto, supplying the user, from the information service via the network, with a computer readable encoding of one or more form documents, wherein the form documents are specific to the at least one target jurisdiction and at least one associate; and
 - receiving from the user, at the information service via the network, one or more documents suitable for filing and in accordance with the one or more form documents, and forwarding same to the selected at least one associate for filing in the selected at least one target jurisdiction.
16. (Previously Presented) The method of claim 15, further comprising:

registering one or more associates for the making of intellectual property filings in respective one or more target jurisdictions, the registering including updating a data store with computer readable encodings of one or more form documents specific to at least one associate and the respective at least one target jurisdiction.

17. (Previously Presented) The method of claim 15, further comprising: providing one or more quoted fees associated with both the at least one target jurisdiction and the at least one associate, wherein the supplying of the computer readable encoding of one or more form documents is contingent upon authorization by the user of the quoted fees.

18. (Previously Presented) The method of claim 15, further comprising: providing one or more quoted fees associated with both the at least one target jurisdiction and the at least one associate substantially coincident with the selection; and

transacting the quoted fees substantially coincident with the one or more of the selection, the receiving of one or more documents and the filing in the selected target jurisdiction.

19. (Original) The method of claim 18, wherein the transacting includes one or more of debiting a deposit account, executing a wire transfer, and electronically authorizing payment of the quoted fees using a credit card, debit card or other payment system.

20. (Previously Presented) The method of claim 15, further comprising:

responsive to the selection by the user of the at least one target jurisdiction and the at least one associate corresponding thereto, retrieving a computer readable encoding of target jurisdiction filing requirements for technical documents; and preparing one or more technical documents of the one or more documents suitable for filing in accordance with the target jurisdiction filing requirements for technical documents.

21. (Previously Presented) The method of claim 20, further comprising: supplying the user, via the network, with the computer readable encoding of target jurisdiction filing requirements for technical documents; and performing the preparing at the user's site using the computer readable encoding of target jurisdiction filing requirements; and receiving from the user, via the network, the prepared one or more technical documents for forwarding to the selected at least one associate.

22. (Previously Presented) A computer implemented method of operating a one-stop intellectual property filing service, the method comprising: receiving at a computer, a transmission from a user, having at least one selection two or more target jurisdictions and corresponding one or more associates for an intellectual property filing; in response to the at least one selection, supplying a transmission from the computer to the user, of one or more target jurisdiction and associate specific documents for completion;

- receiving, at the computer, the completed one or more target jurisdiction and
associate-specific documents; and
- forwarding, from the computer, respective ones of the target jurisdiction and
associate-specific documents, to each of the selected one or more
associates for filing in respective of the selected two or more target
jurisdictions.
23. (Previously Presented) The method of claim 22, further comprising:
providing one or more quoted fees associated with the selected two or more target
jurisdictions and corresponding one or more associates, wherein the
supplying of one or more target jurisdiction and associate-specific
documents for completion is contingent upon authorization by the user of
the one or more quoted fees.
24. (Previously Presented) The method of claim 22, further comprising:
populating the one or more target jurisdiction and associate-specific documents
with matter specific information.
25. (Previously Presented) A computer implemented method for initiating
filing of one or more intellectual property related documents, said method comprising:
selecting one or more target jurisdictions from amongst a set of supported
jurisdictions; and
responsive to each selected target jurisdiction,
obtaining a computer readable encoding of one or more form documents, wherein
the one or more form documents are specific to the target jurisdiction and
to a respective associate therefor; and

supplying at least a portion of a set of filing documents in accordance with the one or more form documents, for transfer to the respective associate suitable for filing in the selected one or more target jurisdiction.

26. (Original) The computer implemented method of claim 25, further comprising for each selected target jurisdiction:

completing the one or more form documents in accordance with matter specific information retrieved from a data store.

27. (Original) The computer implemented method of claim 25, further comprising:

selecting the respective associate from amongst a set of supported associates.

28. (Original) The computer implemented method of claim 25, wherein the obtaining is from an intellectual property filing portal; and wherein the supplying for transfer includes supplying a computer readable encoding to the intellectual property filing portal for forwarding to the respective associate.

29. (Original) The computer implemented method of claim 25, wherein the obtaining is from an intellectual property filing portal.

30. (Original) The computer implemented method of claim 25, wherein the supplying for transfer includes forwarding a computer readable encoding to the respective associate.

31. (Previously Presented) The computer implemented method of claim 25, wherein the obtaining and the supplying are via a network; and

wherein the supplied portion of the set of filing documents includes at least a computer readable encoding of one or more technical documents.

32. (Previously Presented) The computer implemented method of claim 25, wherein the supplied portion of the set of filing documents includes one or more technical documents and completed ones of the one or more form documents.

33. (Previously Presented) A computer implemented method for initiating filing of one or more intellectual property related documents, said method comprising:

- selecting one or more target jurisdictions from amongst a set of supported jurisdictions;
- for at least one selected target jurisdiction, selecting from amongst one or more attorneys or agents available therefor; and
- for each selected target jurisdiction,
 - transforming a computer readable encoding of intellectual property application data to a format appropriate for filing and consistent with requirements of the selected target jurisdiction, the transforming being in accordance with a computer readable encoding of filing requirements for the selected target jurisdiction;
 - and
 - electronically transmitting the transformed computer readable encoding to an attorney or agent for filing in the selected target jurisdiction.

34. (Original) The method of claim 33,

wherein the transforming is further in accordance with a computer readable
encoding of the selected attorney or agent's requirements.

35. (Original) The method of claim 33,
wherein the intellectual property application data includes contents of a priority
application.

36. (Original) The method of claim 33,
wherein the intellectual property application data includes data retrieved from a
docket system.

37. (Original) The method of claim 33,
wherein the electronically transmitting is via an information service intermediary;
and
further comprising receiving from the information service intermediary at least
the computer readable encoding of filing requirements for the selected one
or more target jurisdictions.

38. (Original) The method of claim 33,
wherein the electronically transmitting is via an information service intermediary;
and
wherein the transforming is performed by the information service intermediary.

39. (Original) The method of claim 33,
wherein the one or more intellectual property related documents include at least
one of an intellectual property application, an amendment, a transmittal
paper, an appointment of agent, and a legalization paper.

40. (Original) The method of claim 33, further comprising:

representing the intellectual property application data in a target-neutral format
prior to the transforming thereof.

41. (Previously Presented) A computer implemented method of preparing one
or more intellectual property filings, said method comprising:

receiving, at a target computer, a selection of one or more target jurisdictions
from an originating computer system;

responsive to the receipt of the selection, supplying, from the target computer to
the originating computer system, a

computer readable encoding of filing requirements for the selected one or more
target jurisdictions; and

receiving, at the target computer, in computer readable form, at least one
document suitable for filing in respective ones of the selected one or more
target jurisdictions and prepared at the originating computer system in
accordance with the computer readable encoding of filing requirements.

42. (Previously Presented) The computer implemented method of claim 41,
further comprising:

for each target jurisdiction selection, receiving a selection of at least one attorney
and/or agent corresponding thereto,

wherein the computer readable encoding of filing requirements includes attorney-
and/or agent- specific requirements for at least the selected at least one
attorney and/or agent.

43. (Previously Presented) The computer implemented method of claim 41,
further comprising:

transmitting, for at least one of the selected one or more target jurisdictions, a computer readable encoding of a technical document for filing in the selected one or more selected target jurisdictions.

44. (Previously Presented) An information system for preparing intellectual property filings for at least one target in accordance with requirements therefor, the information system comprising:

- a selection facility by which a user thereof selects the at least one target;
- a retrieval interface to intellectual property application data stored;
- a retrieval interface to requirement data corresponding to the target;
- a filing preparation facility responsive to the selection facility to
 - transform the intellectual property application data into a target specific intellectual property application filing format suitable for filing in accordance with the target requirement data; and
 - prepare at least one additional document in accordance with the intellectual property application and suitable for filing in accordance with target requirement data

for each target selected by the user.

45. (Original) The information system of claim 44, further comprising:
a communications interface for transmitting the transformed intellectual property application data and the at least one additional document for filing.

46. (Original) The information system of claim 44, further comprising:
a data store, responsive to the retrieval interface, for storing the intellectual property application data.

47. (Previously Presented) The information system of claim 44,
wherein the target includes a target jurisdiction and/or convention; and
wherein the target requirement data includes filing requirements for the target
jurisdiction and/or convention.

48. (Previously Presented) The information system of claim 47,
wherein the target further includes an attorney and/or agent; and
wherein the target requirement data further includes attorney- and/or agent-
specific requirements.

49. (Previously Presented) The information system of claim 44,
wherein the intellectual property application data includes a priority application
data content corresponding to a previously filed intellectual property
application.

50. (Original) The information system of claim 44,
wherein the target-specific intellectual property application filing format is an
electronic format for transmission to the target.

51. (Previously Presented) The information system of claim 44,
embodied as a client application executable on a originating computer and
implementing:
the selection facility,
the retrieval interface to intellectual property application data,
the retrieval interface to requirement data; and
the filing preparation facility
and including a communications interface to a server application; and

wherein at least the requirement data is hosted by the server application.

52. (Original) A computer program product encoded in a computer readable medium, the computer program product comprising:

selection code executable to select one or more target jurisdictions and respective associates from amongst a set of target jurisdictions and associates therefor;

retrieval code executable to retrieve, in accordance with the selection, a computer readable encoding of target jurisdiction- and associate- specific filing requirements;

document preparation code executable to prepare one or more target jurisdiction- and associate-specific documents in accordance with the retrieved requirements; and

filing initiation code executable to transmit the prepared documents for filing by the selected one or more associates in the selected one or more target jurisdictions.

53. (Original) The computer program product of claim 52,

wherein the selection code, the retrieval code, the document preparation code and filing initiation code are all executable on a same processor.

54. (Original) A method of making a computer readable encoding of one or more target jurisdiction- and associate-specific form documents, the method comprising:

maintaining a data store of target jurisdiction- and associate-specific form documents for transacting an intellectual property filing in the target jurisdictions using respective of the associates;

encoding, based on contents of the data store, an enumeration, for transmission to
a computer, of at least a subset of the target jurisdictions and respective of
the associates therefor;

receiving a selection of one or more of the target jurisdictions and respective
associates;

retrieving, based on the selection, corresponding of the target jurisdiction- and
associate-specific form documents; and

encoding as a response to the selection for transmission to the computer, the
retrieved target jurisdiction- and associate-specific form documents.

55. (Previously Presented) The method of claim 54, further comprising:
registering individual one or ones of the associates for fulfillment of intellectual
property filings in respective of the target jurisdictions.

56. (Original) An intellectual property filing preparation system comprising:
means for selecting one or more target jurisdictions and respective associates;
means for obtaining form documents specific to each selected target jurisdiction
and associate;
means for completing the obtained form documents in accordance with matter
specific data; and
means for transmitting a technical document and respective of the completed form
documents for filing by the selected associates.

57. (Previously Presented) The method of claim 22, wherein, the one or more target jurisdiction and associate-specific documents include one or more technical documents.